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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/625,659	07/24/2003	William Patrick Tunney	11884/404501	8909

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EXAMINER	
PATEL, SHEFALI D	
ART UNIT	**PAPER NUMBER**
2624	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/06/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/625,659	TUNNEY, WILLIAM PATRICK	
	Examiner	Art Unit	
	Shefali D. Patel	2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12/22/06*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-17* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *9-11,14 and 15* is/are allowed.

6)☒ Claim(s) *1-8,12,13,16 and 17* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. The amendment was received on December 22, 2006.

2. Double patenting rejection stands still because of the new similar amendment made also to the co-pending Application No. 10/625,597.

3. Claims 9-11 and 14-15 are allowed.

Response to Arguments

4. Applicant's arguments filed under Remarks on pages 6-9 on December 22, 2006 have been fully considered but they are not persuasive.

Applicant argue on page 6 stating:

> "None of these references in Wolff constitutes "if portions of the capture data conflict, selecting the portion of the conflicting capture data that was captured last as the capture data" of claim 1."

The examiner respectfully disagrees.

The applicant's arguments are flawed stating that Wolff does not disclose the newly amended limitation. Wolff discloses this and teaches resolving conflicts in data entry at col. 6 line 4-30. The last captured data is entered if the user decides that is what the user is intended to do. If not, then the loop starts again and user enters new entry. This clearly resolves any conflicts that may occur. Wolff does resolve the conflicts in entry data. Yes, it might not be the clock time but it is the data entry that is being resolved if the conflict exists. Please keep in mind that the previous claim rejection was made under 35 U.S.C. 103(a) using Wolff in view of Ericson who discloses the calendar data in memory. Please see the rejection below.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct

from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 6-7, 12-13 and 16-17 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 9-10, 14-15 and 17-18 of copending Application No. 10/625,597 in view of Wolff et al. (USPN 6,081,261).

Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claims recite "time" and the copending application recites "date". The two are similar when it comes to its definition. Date is described as "the time or period to which any event or thing belongs" according to www.dictionary.com. Also, Wolff discloses time on the paper form and at the time of the invention, it would have been obvious to a person of ordinary skill in the art to use the teaching of Wolff for coordinates of time rather than date (note, Wolff discloses both time and date).

Therefore, they are obvious over the co-pending application.

Dependent claims 8-15 are rejected for the same reasons.

This is a provisional obviousness-type double patenting rejection.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 1-8 and 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolff et al. (hereinafter, "Wolff") (US 6,081,261) in view of Ericson (US 6,666,376).

With regard to **claim 1** Wolff discloses a method comprising (Figures 1 and 5): receiving capture data from a capture device, the capture data representing positions of a set of marks made on paper overlaying a face (col. 5 lines 1-30) of the capture device (col. 3 lines 26-65, col. 7 lines 6-9 and col. 9 lines 44-46); if portions of the capture data conflict, selecting the portion of the conflicting capture data that was captured last as the capture data (col. 6 lines 4-30); comparing the capture data with one of a plurality of unique positions stored in memory in association with a plurality of clock times (note the clock time in Figure 1 and at col. 3 lines 48, 51 and 54-56) printed on the paper (col. 5 lines 22-26 and the calendar book information is disclosed at col. 3); retrieving from memory the clock time associated with the unique position that matches the capture data (col. 5 lines 48-55 and lines 1-6). Wolff does not expressly disclose storing the retrieved clock time in memory as the set of marks made on the paper. Ericson discloses this at col. 7 lines 25-38 and also on col. 5 lines 29-39. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the teaching of Ericson with Wolff. The motivation for doing so is to determine the unique clock time period, which identifies the first calendar area, thereby enabling the creation of an electronic back-up of the calendar as suggested by Ericson. Therefore, it would have been obvious to combine Ericson with Wolff to obtain the invention as specified in claim 1.

With regard to **claims 2 and 3** both Wolff and Ericson discloses the coordinates (x,y) and (x,y,t). Wolff at col. 7 lines 21-22, col. 8 lines 7-17, 26, 37 and 45. See, Ericson at col. 7 line 46.

With regard to **claim 4** Wolff discloses capturing data simultaneously with the making of the set of marks on the paper (col. 2 lines 48-56, col. 4 lines 21-23).

With regard to **claim 5** Wolff discloses receiving a set of points from the capture device, the set of points representing orientation of the paper on the capture device; and determining the positions of the set of marks relative to the set of points (col. 8 lines 40-63).

Claim 6 is rejected the same as claim 1. Thus, arguments similar to that presented above for claim 1 is equally applicable to claim 6. Claim 6 distinguishes from claim 1 only in that it recites mapping the set of coordinates to a data. Ericson discloses this at col. 6 lines 26-39 and line 66 to col. 7 line 20.

Claim 7 is the same as claim 3 where the time was included in the vector coordinates.

With regard to **claim 8** both Wolff and Ericson discloses the clock and the boxes associated AM and PM (Wolff - col. 3 lines 54-55).

Claim 16 is rejected the same as claim 6 except claim 16 is a system claim. Thus, arguments similar to that presented above for claim 6 is equally applicable to claim 16. Note, Wolff discloses a memory and a processor along with a display as seen in Figure 5 and its respective portions in the specification.

Claim 17 is the same as claim 3 where the where and when was included in the vector (i.e., x,y,t).

Allowable Subject Matter

9. Claims 9-11 and 14-15 are allowed.

10. Claims 12-13 are objected to as being dependent upon a rejected base claim (Double Patenting Rejection), but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and resolve the double patenting rejection.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shefali D. Patel whose telephone number is 571-272-7396. The examiner can normally be reached on M-F 8:00am - 5:00pm (First Friday Off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew Bella can be reached on (571) 272-7778. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Shefali D Patel
Examiner
Art Unit 2624

sdp

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